

### Remarks

Claims 1-18 are currently pending in the present patent application. Claims 1-4, 6-9, 11-12 and 15-18 have been amended. For the convenience of the patent examiner, Applicant will address the issues raised in the order presented in the Office Action dated March 20, 2007.

#### Claim Rejections – 35 USC § 112

1.-3. Claims 11-12 and 15-18 appear to have been rejected under 35 USC § 112. In response, certain recitations of the word, “means” have been deleted from the claims. Reconsideration and withdrawal of the rejection under 35 USC § 112 is requested.

#### Claim Rejections – 35 USC § 102

4.-5. Claims 1-3 and 6-7 were rejected under 35 USC § 102(e) as being allegedly anticipated by U.S. Pat. Pub. No. 2005/0248437 (Hellebust). To anticipate a claim under 35 USC § 102(e), the Hellebust reference must disclose each and every element of the claim. MPEP 2131. With regard to the claimed subject matter of this particular patent application, Hellebust does not.

Hellebust is directed to a wireless device that can display the number of voice mails, e-mails, pages, and Internet information alerts that have been received by the wireless device during a specified time period. The wireless device also allows the incoming information to be separated by any number of user specified criteria.

The 35 USC § 102(b) rejection of claim 1 should be withdrawn because the Hellebust wireless device does not disclose altering a first indicator to provide a second indicator providing an annunciation that new unread electronic messages have been received since the unread electronic messages received were last scanned. See page 9, lines 20-21 to page 10, line 1 of the Office Action dated March 20, 2007 where the patent examiner admits that the Hellebust reference does not disclose a second indicator means on the display comprising an alteration to said first indicator means to provide an annunciation of the presence of new unread electronic messages received since the message list was last displayed. An element similar to the admitted Hellebust deficiency was added to amended claim 1. In view of the foregoing, amended claim 1 is considered allowable. Reconsideration and withdrawal of the rejection to claim 1 under 35 USC § 102(e) is requested.

Since independent claim 1 is believed to be allowable over Hellebust for the reasons

provided above, dependent claims 2-3 are believed to be allowable as well as a matter of law. With regard to the rejection of claims 6-7, the rejection of these claims is improper since these claims depend from claim 4 not claim 3 as is alleged in the Office Action dated March 20, 2007. Please see the Preliminary Amendment dated July 11, 2005 that was filed in this patent application. Reconsideration and withdrawal of the rejections to claims 1-3 and 6-7 under 35 USC § 102(e) is requested.

### **Claim Rejections – 35 USC § 103**

6.-7. Claims 4-5, 8 and 11-18 were rejected under 35 USC § 103(a) as being unpatentable over Hellebust in view of U.S. Pat. Pub. No. 2002/0160817 (Salmimaa). MPEP 2142 states that three criteria must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

The 35 USC §103(a) rejection should be withdrawn because Hellebust or Hellebust and Salmimaa when combined do not teach or suggest all the claim recitations of independent claims 4, 8 and 11. With regard to the Hellebust reference, it does not meet the recitations of claims 4, 8 and 11 for similar reasons provided above with regard to the rejection of claims 1-3 and 6-7 under 35 USC § 102(e). Those reasons are incorporated by reference into this section as if fully set forth herein.

With regard to the combination of the Hellebust reference and the Salmimaa reference, the combination does not meet the claim recitations of independent claims 4, 8 and 11 because **Salmimaa, like Hellebust, does not generate a second indicator providing an annunciation that new electronic messages have been received since the unread electronic messages received were last scanned.** Salmimaa alters icons based on context values such as time of day, geographic area, or user profile preferences. The Salmimaa icon alteration process does not occur since unread electronic messages received were last scanned as is claimed in claims 4, 8 and 11. See paragraph [0013] of Salmimaa and compare that

description to page 5, lines 18-30 of the patent application. That section of the specification provides the recitation of, “since the unread messages received were last scanned” used in claims 4, 8 and 11 with certain aspects into the meaning of that recitation. Salmimaa, like Hellebust, does not have a comparable structure or process to that claim recitation.

Also, with regard to claim 11, paragraph [0038] of Salmimaa does not disclose an input means for selectively displaying the message list on the display as is alleged on page 10 of the Office Action dated March 20, 2007. Paragraph [0038] discloses modifying context values not selectively displaying the message list on the display.

In view of the foregoing, claims 4, 8 and 11 are considered allowable. Reconsideration and withdrawal of the rejection to claims 4, 8 and 11 under 35 USC § 103(a) is requested.

Since independent claim 4 is believed to be allowable over Hellebust and Salmimaa for the reasons provided above, claim 5 which depends from claim 4 is believed to be allowable as well as a matter of law. Also, since independent claim 11 is believed to be allowable over Hellebust and Salmimaa for the reasons provided above, dependent claims 12-18 which depend directly or indirectly from claim 11 are believed to be allowable as well as a matter of law.

Additionally, with regard to claim 16, the patent examiner admits on page 13, lines 3-4 of the Office Action dated March 20, 2007 that Hellebust and Salmimaa do not disclose a message icon on the display adjacent to the count of unread electronic messages received. The patent examiner then alleges that it would be obvious to add a message icon on the display adjacent the count of unread electronic messages without citing any references to support such a conclusion. It would appear that the patent examiner has improperly applied reliance on supposed common knowledge in the art under MPEP 2144.03. It is respectfully asserted that it is not “well known” in the art of managing electronic messages to add a message icon on the display adjacent to the count of unread electronic messages as is claimed in claim 16.

For example, it has been held proper to take judicial notice of the fact that tape recorders commonly erase tape automatically when new audio information is recorded on a tape which already has a recording on it. In the present case, however, it is not “notorious” or “well known” in the art of managing electronic messages to add a message icon on the display

adjacent to the count of unread electronic messages as is claimed in claim 16. If it is so “notorious” or “well known” in the art of managing electronic messages to add a message icon on the display adjacent to the count of unread electronic messages as is claimed in claim 16, why has such a reference not been located? The answer is that it is not “notorious” or “well known” in the art of managing electronic messages to add a message icon on the display adjacent to the count of unread electronic messages as is claimed in claim 16. If the patent examiner decides to continue to maintain this rejection of claim 16, Applicant respectfully requests that the patent examiner cite a reference that supports the conclusory statements with regard to claim 16. Reconsideration and withdrawal of the rejections to claims 4-5, 8 and 11-18 under 35 USC § 103(a) is requested.

8. Claims 9 and 10 were rejected under 35 USC § 103(a) as being unpatentable over Hellebust in view of Salmimaa as applied to claim 7, and further in view of Mastering Windows 95 (Cowart). Since independent claim 4 is believed to be allowable over Hellebust and Salmimaa for the reasons provided above, claims 9-10 which depend indirectly from claim 4 are believed to be allowable as well as a matter of law. Reconsideration and withdrawal of the rejection to claims 9-10 under 35 USC § 103(a) is requested.

### **Conclusion**

It is respectfully submitted that the present application is in condition for allowance. If the patent examiner would like to suggest changes of a formal nature to place this application in better condition for allowance, a telephone call to Applicant’s undersigned attorney would be appreciated.

Respectfully submitted,



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